

VI. REMARKS/ARGUMENTS

A. Status of the Application

Claims 1 and 3-12 are pending. Claims 1 and 8 are amended. Claims 2, 13 and 14 are cancelled. Reconsideration of this application in light of the following remarks is respectfully requested.

B. Objection to the Drawings

In response to the objection to the drawings, FIGS. 1A and 1B have been amended to include the designation "Prior Art". A replacement sheet which incorporates the amendments to FIGS. 1A and 1B is submitted herewith.

C. Objection to the Abstract of the Disclosure

The Abstract of the Disclosure has been amended in accordance with MPEP § 608.01(b). Accordingly, it is requested that the objection to the Abstract of the Disclosure be withdrawn.

D. Rejection of Claims 1-4, 6 and 8-11 under 35 U.S.C. § 102(b)

Claims 1-4, 6 and 8-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,071,577 to Rego ("Rego '577"). As noted above, claim 2 has been cancelled. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

Independent Claim 1 is directed to a utility portal frame that includes (a) a base plate having an aperture to provide a portal entrance and an outer peripheral edge, and (b) at least one side wall dependent from the base plate, the at least one side wall extending substantially orthogonally relative to the base plate from the outer peripheral edge, wherein the frame includes a means adapted to facilitate raising of the frame from a first position to a second position substantially without disturbance to material surrounding the at least one side wall. Claims 3-4 and 6 depend from and include the subject matter of claim 1.

Independent Claim 8 is directed to a utility portal that includes (a) a frame, which includes a base plate having an outer peripheral edge, and at least one wall, which at least one wall extends substantially orthogonally from the outer peripheral edge; and (b) a cover

engageable with the frame; wherein the frame includes a means adapted to facilitate raising of the frame from a first position substantially below a new surface plane to a second position to align with the new surface plane substantially without disturbance to an existing surface adjacent to the frame. Claims 9-11 depend from and include the subject matter of claim 8.

As provided in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim ...". Rego '577 fails to satisfy the requirements of MPEP § 2131 because Rego '577 does not disclose each and every element of claims 1, 3-4, 6 and 8-11.

Rego '577 discloses a device for preventing manhole covers from "blowing off" when gases accumulate within the manhole leading to an explosion. Contrary to the claimed utility portal and utility portal frame, however, Rego '577 does not disclose or suggest that the manhole cover device includes a means adapted to facilitate raising of the frame from a first position to a second position substantially without disturbance to an existing surface adjacent to or material surrounding the side wall of the frame.

Therefore, Rego '577 does not disclose or suggest the subject matter of claims 1, 3-4, 6 and 8-11. Accordingly, it is respectfully submitted that the rejection of claims 1, 3-4, 6 and 8-11 over Rego '577 is improper and should be withdrawn.

E. Rejection of Claims 5, 7 and 12 under 35 U.S.C. § 103(a)

Claims 5, 7 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rego '577. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

To sustain the present rejection of claims 5, 7 and 12 under 35 U.S.C. § 103(a), a prima facie case of obviousness must be established. MPEP § 2142 provides that a prima facie case of obviousness requires three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations.

As noted above, independent claim 1 is directed to a utility portal frame that includes (a) a base plate having an aperture to provide a portal entrance and an outer peripheral edge, and (b) at least one side wall dependent from the base plate, the at least one side wall extending substantially orthogonally relative to the base plate from the outer peripheral edge, wherein the frame includes a means adapted to facilitate raising of the frame from a first position to a second position substantially without disturbance to material surrounding the at least one side wall.

Claims 5 and 7 depend from and include the subject matter of claim 1.

Independent claim 12 is directed to a method of raising a utility portal frame from a first position to a second position that includes (a) engaging a jack in a jack point provided in a base plate of a frame secured to a mounting surface at the first position; and (b) operating the jack to raise the frame from the first position to the second position, wherein at least one wall dependent from the base plate and extending substantially orthogonally relative to the base plate slides upwardly relative to material surrounding the frame without substantially disturbing the surrounding material.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner clearly cannot establish a *prima facie* case of obviousness in connection with claims 1 and 12 for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

As noted above, Rego ‘577 discloses a device for preventing manhole covers from “blowing off” when gases accumulate within the manhole leading to an explosion. Rego ‘577, however, does not teach, suggest or motivate a device that includes a means adapted to facilitate raising of the frame from a first position to a second position substantially without disturbance to material surrounding the side wall of the frame as claimed in claim 1. Rego ‘577 also does not

teach, suggest or motivate a method of raising a utility portal frame that includes (a) engaging a jack in a jack point provided in a base plate of a frame secured to a mounting surface at the first position; and (b) operating the jack to raise the frame from the first position to the second position, wherein at least one wall dependent from the base plate and extending substantially orthogonally relative to the base plate slides upwardly relative to material surrounding the frame without substantially disturbing the surrounding material.

Therefore, it is impossible to render the subject matter of claims 5, 7 and 12 as a whole obvious based on Rego '577, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 5, 7 and 12, and a rejection under 35 U.S.C. §103(a) is therefore improper.

There is still another compelling, and mutually exclusive, reason why Rego '577 cannot be applied to reject claims 5, 7 and 12 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Rego '577 does not teach, suggest or motivate the desirability of the subject matter of claims 5, 7 and 12 since the patent does not teach, suggest or motivate a device that includes a means adapted to facilitate raising of the frame from a first position to a second position substantially without disturbance to material surrounding the side wall of the frame or a method of raising a utility portal frame from a first position to a second position in which a jack is operated to raise the frame from the first position to the second position.

Thus, Rego '577 does not provide any incentive or motivation supporting the desirability of the subject matter of claims 5, 7 and 12. Therefore, there is simply no basis in the art to support a rejection of claims 5, 7 and 12 under 35 U.S.C. §103(a) over Rego '577.

In addition, the Office action mailed July 12, 2007 alleges that:

“It is also standard practice to elevate manhole structures during repaving operations in order to obtain a flush finished surface.” (Office Action at p. 3).

Applicants traverse the alleged “standard practice” and instead submit that the ability of the portal frame of the present invention to be raised or removed easily and effectively without substantial excavation of the frame or adjacent surface of the road is a novel and inventive feature. Consequently, and in accordance with MPEP § 2144.03, Applicants demand that the Examiner provide documentary evidence of the alleged “standard practice” or withdraw the rejection of claims 5, 7 and 12 under 35 U.S.C. § 103(a) over Rego ‘577.

For all of the foregoing reasons, it is clear that the rejection of claims 5, 7 and 12 under 35 U.S.C. §103(a) over Rego ‘577 should be withdrawn.

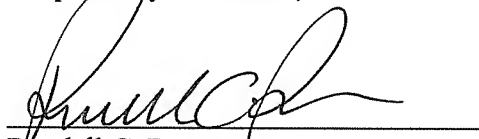
Conclusion

Claims 1 and 3-12 are now pending in the present application. In view of the foregoing remarks, allowance of claims 1 and 3-12 is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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